

RESPONSE
Examiner: SON, Linh L.D.

Serial No. 09/663281
Atty. Docket No.: 46354.010200

REMARKS/ARGUMENTS

Claims 1-13 and 16-25 are currently pending in the above-referenced patent application. In light of the Examiner's clear determination to reject Applicants' patent application despite Applicants' having properly overcome the Examiner's arguments, Applicants have filed the attached Notice of Appeal and respectfully request a Pre-Appeal Conference.

Examiner's Response to Applicant's Arguments

The Examiner rejected Claims 1-13 and 16-21 under 35 U.S.C. §103(a) as being unpatentable over Bostley, III et al, U.S. Patent No. 6,201,871B1 (referred to herein as "Bostley"), in view of Cardano Grilles (referred to herein as "Grilles") for the same reasons set forth in the previous Office Action. Applicants respectfully traverse the rejections in their entirety for at least the reasons set forth herein and in the May 9, 2005 response, which is incorporated herein by reference in its entirety. In maintaining the Examiner's earlier rejections, the Examiner asserts that Applicants' arguments filed May 9, 2005 have been fully considered but are not persuasive.

The arguments made by the Examiner in dismissing Applicants' arguments are inconsistent, contradictory, and in many cases contrary to well-settled law. For example, in response to Applicants arguments the Examiner admits that "it is obvious the overlay technique in Grille can not be applicable in the technological art" (emphasis added) (Office Action, p. 2). In light of the Examiner's admission, Applicants struggle to understand how the Examiner can then assert that it would be obvious to one skilled in the art to "intelligently transform the technique into an electronic operation" (Office Action, p. 2). The Examiner has taken two contradictory points of view with respect to Grilles in the span of two sentences. Applicants agree with the Examiner that Grilles cannot be applicable in the technological art, and respectfully request that the Examiner withdraw the rejection.

Similarly, the Examiner's position later in the Office Action is contradictory to the Examiner's own earlier assertions. As described above, the Examiner asserts that "it is obvious the overlay technique in Grille can not be applicable in the technological art." If this is the case, how can the Examiner then assert that "it is clearly and obvious [sic] for one having ordinary skill in the art at the time of the invention was made [sic] to modify Bostley's invention to implement the Grille technique..." (Office Action, page 3)? Applicant asserts that, as the Examiner has acknowledged, Grilles is not "applicable in the technological art" (Office Action,

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page 2), therefore one skilled in that same technological art would not have any motivation, absent hindsight gained by the instant patent application, for making the combination suggested by the Examiner. Applicant again respectfully requests that the Examiner reconsider the position taken in the July 27, 2005 Office Action and withdraw the rejection.

The Examiner's arguments are also contrary to the law. On page 3, the Examiner acknowledges Applicant's argument that Bostley teaches away from combining Bostley with another reference in the manner claimed in the instant application. The Examiner does not dispute that Bostley teaches away from Applicants' claimed invention, yet the Examiner asserts that "Nevertheless, as recited in the previous rejection...It is clearly and obvious [sic] for one having ordinary skill in the art at the time of the invention was made [sic] to modify Bostley's invention to implement the Grille technique...". The Court of Appeals for the Federal Circuit has consistently held that it is "error to find obviousness where references 'diverge from and teach away from the invention at hand'." (emphasis added) In re Fine, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). The Examiner's continued reliance on the combination of Bostley and Grilles is therefore clear error. The Examiner's position is contrary to the well-settled law in this area, and Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

Furthermore, the Examiner still fails to appreciate the distinctions between Applicants' claimed invention and the prior art cited by the Examiner. In response to Applicants' argument that the Grilles technique is a cardboard overlay (which is the Examiner's own characterization of the Grilles invention, as recited in the February 9, 2005 Office Action) from which the selected letters are read in a sequential order, the Examiner asserts that "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim." Applicants are confused by the Examiner's statement. Applicants have not merely "recited an intended use of the claimed invention" - instead, Applicants have attempted to call to the Examiner's attention the structural differences between the claimed invention and the prior art. In Grilles, the characters are read through the holes in the cardboard overlay in sequential order. Moreover, in Grilles, a message must first be written through the holes in the cardboard overlay before the remaining squares are populated with letters. This means that Grilles inherently does not use, nor can it use, a pseudo-random string. In the claimed invention, "the mask code is

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applied to the pseudo-random string in accordance with predetermined rules so as to generate a volatile identification code" (Claim 1, emphasis added). In an effort to reinforce the structural differences between the claimed invention and the Grilles technique, Applicants called the Examiner's attention to page 5, line 22 through page 6, line 5, of the above-referenced patent application, as filed. This portion of the specification makes it clear that the "mask code" recited in Applicants' claims is not a simple overlay, as in Grilles. Unlike Grilles, where the underlying message is predetermined, in Applicants' invention the volatile identification is not predetermined, but rather is generated by applying the "mask code" to the pseudorandom string. In the present invention, the characters of the pseudorandom string are selected in positional order determined by the mask code (e.g., where the mask code is 6359, the volatile identification code will be the sixth, third, fifth, and ninth character from the pseudorandom string). The Examiner's failure to fully appreciate the distinctions between the claimed invention and the prior art has resulted in the Examiner improperly maintaining the rejection, and Applicants respectfully request the Examiner reconsider and withdraw the rejection.

Still further, the Examiner fails to provide any motivation, absent the hindsight provided by Applicants' invention, as to why one skilled in the art would seek to modify Grilles, especially in light of the fact that Grilles "can not be applicable in the technological art" in the first place. As the Court of Appeals for the Federal Circuit has consistently held, "The obviousness standard requires a return to the time the invention was made. The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.... That which may be made clear and thus 'obvious'...with the invention fully diagrammed and aided ... may have been a breakthrough of substantial dimension when first unveiled." Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050 (Fed. Cir. 1988) (citing Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, (Fed. Cir. 1985) and W.L. Gore & Assocs. v. Garlock, 721 F.2d 1540, 1551 (Fed. Cir. 1983)). "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed". In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). The mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. See MPEP § 2143.01, citing In re Mills, 916 F.2d 680 (Fed. Cir. 1990). Further, even if the cited references relied upon by the Examiner do in fact teach the individual

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components of the rejected claims, (a fact that is in no way conceded in the present instance), that fact alone is also not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teaching of the references. Thus, the Examiner can satisfy this burden "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Lee, 277 F.3d 1338, 1343, citing In re Fitch, 972 F.2d 1260, 1265 (Fed. Cir. based 1992). As In re Lee requires, as does In re Zurko, 258 F.3d 1379, 1383-86, the Examiner must set forth with specificity where the motivation exists in the cited references, or, if the Examiner is relying on general knowledge of the art, that general knowledge must be capable of readily documented substantiation. If the Examiner is relying on well-known facts or common knowledge in the art to provide the motivation, such facts and knowledge must be of a nature that are "capable of instant and unquestionable demonstration as being well-known." MPEP § 2144.03.A., citing In re Ahlert, 424 F.2d 1088, 1091 (CCPA 1970) (requiring that the notice of facts beyond the record which may be taken by the Examiner must be capable of instant and unquestionable demonstration so as to defy dispute), and Applicants respectfully request that the Examiner produce evidence that such facts are common knowledge. The Examiner has not provided any findings that even suggest the modifications to Grilles relied upon by the Examiner in sustaining the rejection other than the blueprint drawn by Applicants in the instant patent application, and Applicants respectfully request that the Examiner reconsider the position taken in the July 27, 2005 Office Action and withdraw the rejection.

Applicants also assert that the combination of Grilles and Bostley would be inoperable for its intended purpose. It is generally settled law that a change in a prior art device which makes the device inoperable for its intended purpose cannot be considered to be an obvious change. Hughes Aircraft Co. v. United States, 215 USPQ 787, 804 (Ct. Cl. Trial Div. 1982), AFF'D IN PART, REV'D IN PART, 717 F.2d 1351, 219 USPQ 473 (Fed. Cir. 1983). In the instant Office Action, modifying Grilles in a manner consistent with Bostley as suggested by the Examiner would render Grilles inoperable for its intended purpose. Applicants therefore respectfully request that the Examiner withdraw the rejection.

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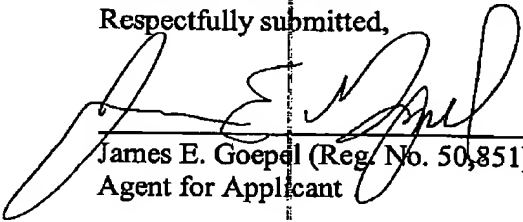
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Having responded to all objections and rejections set forth in the outstanding Office Action, it is submitted that the currently pending claims are in condition for allowance and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is courteously requested to contact applicant's undersigned representative.

Respectfully submitted,


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